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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,057	03/15/2005	Francesco Arduini	23237	9026

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EXAMINER	
KIM, WESLEY LEO	
ART UNIT	**PAPER NUMBER**
2617	
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01/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/528,057	ARDUINI ET AL.	
	Examiner	Art Unit	
	Wesley L. Kim	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/15/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are of poor quality and labeled by hand. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

1. Claims 5-13 and 18-29 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim is further dependent on another multi-dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5-13 and 18-29 have not been further treated on the merits.
2. Claim 2 is objected to as being in improper form because of the use of a period, ".", when a comma, (","), should be used. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See Fressola v. Manbeck, 36 USPQ2d 1211 (D.D.C. 1995).
3. Claims 1-4, 9-12, 14-18, 23, and 25-27 are objected to because of the following informalities: There are acronyms (UMTS, WLAN) being used within the claims, where they have never been defined within the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
2. Claims 2 and 16 recite that a first set of services may be provided through second system and a second set of services may be provided through both first and systems and by looking at Pg.7;31-Pg.8;10 of specification, it is clear that the first set of services provided by the second system is dealing with conversational services (Pg.7;31-34). The claim is broader than the specification, so the examiner may interpret the claims as desired, however the claim is essentially saying that the second system is utilized by the first set of services (i.e. conversational) because the first system (i.e. WLAN) cannot support conversational services. Yet, a skilled artisan would know that it is well known that a WLAN can support conversational services (Hyvarinen Par.3). The examiner is not sure if there is a mistake in the specification or not. If the examiner is incorrect please point out in further arguments why the examiner is incorrect. The Claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention. The rejections below will be made with the examiners best understanding of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hyvarinen et al (US 2002/0085540 A1).

Regarding Claims 1 and 14, Hyvarinen teaches method for the provision of telecommunications services in an environment in which there are a plurality of systems working according to different standards (WLAN, UMTS) and reachable from a terminal (T) in an integrated way (Par.6 and Fig.2), wherein at least one of said services can be provided by several systems of said plurality (Par.6, a service requested by user can by provided by either system), said method being characterized in that it incorporates a module (Par.20; LDB) capable, when there is a request of provision of said at least one service, of cooperating with said plurality of telecommunications systems (Par.20) : verifying the availability for the provision of the requested service of at least a first (WLAN) and a second (UMTS) system of said plurality (Par.60), and selecting, in an automatic and dynamic way, at least one between said first (WLAN) and said second (UMTS) system of said plurality for the provision of the requested service (Par.6, upon user request, connection between

first or second network occurs automatically and dynamically based on whether or not the service can be provided).

Regarding Claim 15, Hyvarinen further teaches said module is integrated into a controller element common to said at least a first and second system of said plurality (Par.20 and Fig.2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyvarinen et al (US 2002/0085540 A1) in view of Fenton et al (US 2003/0126263 A1).

Regarding Claims 2 and 16, Hyvarinen teaches all the limitations as recited in claims 1 and 14 and Hyvarinen further teaches characterized in that it includes the steps of: a) selecting, among said plurality of systems, at least said first and a second system, said first system forming with regard to said second system, a resource to be exploited in a preferential way (Par.33-34 and Par.6, resource exploited to provide desired service if the system is available); c) in the cases of a provision request for a service of said second set, c1) verifying the availability of said first system in order to provide said service of said second set, as requested and

providing said service of said second set as requested, through said first system if said first system is available (Par.6 and Par.33-34) c2) if said first system is unavailable, for the transmission of a said service of said second set as requested, verifying the availability of said second system to provide said service of said second set, as requested, and providing and not providing said service of said second Set, as requested, depending on whether or not said second system is available for the provision of said service of said second set, as requested (Par.6 and Par.33-34), however Hyvarinen **is silent on** selecting being able to bring to the subdivision of said services into: a first set of services to be substantially provided through said second system, and a second set of services to be provided through both said first system and said second system, b) in the case of a request for provision of a service within said first set, verifying the availability of said second system for providing said service of said first set as requested.

Fenton teaches that certain features of a wireless network are known to operate in certain networks while not in others, such as SMS and voice services will work in 2G and 3G networks while MMS services will only work in 3G networks (Par.2). To one of ordinary skill in the art is obvious that certain services will only work in certain networks and those services will only be provided by the respective network upon verification of available resources or availability of the network as taught in Hyvarinen (See Par.6 and Par.33-34). To a skilled artisan, it is obvious that this teaching reads on the limitation of selecting being able to bring to the subdivision of said services into: a first set of services to be substantially provided

through said second system, and a second set of services to be provided through both said first system and said second system, b) in the case of a request for provision of a service within said first set, verifying the availability of said second system for providing said service of said first set as requested.

To one of ordinary skill in the art, it would have been obvious to modify Hyvarinen with Fenton such that selecting a first set of services to be substantially provided through said second system, and a second set of services to be provided through both said first system and said second system, b) in the case of a request for provision of a service within said first set, verifying the availability of said second system for providing said service of said first set as requested, to provide a method where a requested service is sought after only within a network where the service is available so that time is not wasted in attempting to obtain service in a network where the service is not even available.

5. Claims 3-4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyvarinen et al (US 2002/0085540 A1) and Fenton et al (US 2003/0126263 A1) in further view of Kim (US 6044091).

Regarding Claims 3-4 and 17, Hyvarinen and Fenton teach all the limitations as recited in claims 2 and 16, respectively, and the combination further teaches verifying the unavailability of said second system for the provision of said service of said subset as requested (Hyvarinen Par.33-34), however the combination **is silent on** once said unavailability has been verified, the step of re-negotiating the provision

request whereby said service of said subset is again requested for the provision in a condition of modified communication resources.

Kim teaches that it is well known in the art that when a service requested cannot be provided due to a lack of resources, a renegotiation will occur to obtain the service at a lower quality of service (Col.5;23-28). To one of ordinary skill in the art, it is obvious that this teaching reads the limitation of once said unavailability has been verified, the step of re-negotiating the provision request whereby said service of said subset is again requested for the provision in a condition of modified communication resources.

To one of ordinary skill in the art, it would have been obvious to modify Hyvarinen and Fenton with Kim such that once said unavailability has been verified, the step of re-negotiating the provision request whereby said service of said subset is again requested for the provision in a condition of modified communication resources, to provide a method where service is provided to the end user even if it is at a quality slightly lower than desired.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley L. Kim whose telephone number is 571-272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WLK

GEORGE ENG
SUPERVISORY PATENT EXAMINER